

REMARKS

Claims 40-59 were subject to the Examiner's Answer as re-mailed September 18, 2009. In that Answer it is alleged that Applicants' argument --that it would not have been necessary to alter the detection technique of Yasuda-- is unpersuasive. Specifically, Applicants position that the substitution of a bead for a nanorod in Yasuda's was unwarranted was dismissed on the basis that the artisan at the time would look to other observation techniques.

No motivation for modifying Yasuda is extant. While Applicants appreciate that KSR Int'l Co. v. Teleflex, Inc., 82 USPQ2d 1835 (U.S. 2007) has restated the law under 35 USC §103, it is submitted that, nonetheless, when a proposed combination modifies the very operation of a primary reference, there still must be evidence to support same. See e.g. In re Kubin, 90 USPQ2d 1417 (Fed Cir 2009); MPEP 2141. Under circumstances where the combination of references goes beyond the mere substituting of one element for another, some evidence of motivation must be articulated. This means evidence other than a bare allegation that the artisan would have been explored other techniques.

Such is the case here. The substitution of Yasuda's bead for a nanorod entails a wholesale revamping of the observation method, from fast frame CCD sequential imaging to the polarized, filtered, light scattered technique of the present claims. The scope of the alterations required in Yasuda as a result of the posited substitution requires more than a bare assertion. It requires an articulated reason as to why one would be motivated to undertake the entirety of all the modifications that attend. None are of record. Applicants respectfully submit that absent express motivation --which is submitted as required under these circumstances given Kubin and MPEP 2141-- they are left without meaningful recourse and are hampered in establishing the contrary: that the claims are not obvious over the art cited and fully merit patenting.

Reconsideration and provision of motivating reasons is respectfully requested.

Additionally, Applicants have provided herewith above, new Claim 60. This claim is directed to a specific embodiment of the invention, including *inter alia* the use of a detection strand DNA whereby the molecular arm rotates if a target DAN strand matches. See page 14 of the instant specification. No new matter is involved.

Applicants request favorable consideration and passage of issuance of the present application.

Respectfully submitted,



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